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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/628,568	07/31/2000	Leonard G. Presta	A-63470-7/DAV/JJD	6154

7590 08/18/2003

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San Francisco, CA 94111-4187

EXAMINER

SAUNDERS, DAVID A

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 08/18/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
628,568Applicant(s)
ARISTA et alExaminer
SAUNDERS

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 5/8/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1, 21-28 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1, 21-28 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/8/03 has been entered.

Claims 1 and 21-28 are pending and under examination.

The amendment has overcome all bases of rejection stated under 35 U.S.C., first and second paragraphs, except as follows:

Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 28 is unclear. It is believed that —binding epitope—should be recited after “receptor”.

The amendment has necessitated the following new 112 rejections.

Claims 1 and 21-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 28 contains new matter by reciting (line 5) “is taken from at least one loop”.

Recitation of "at least one" encompasses a value of "one" or of any larger integer. The specification, however, has only taught that the epitope is taken from "one or two loops" (pages 13, 17, 18). Likewise, note original claim 5. Applicant has improperly extended claim scope by permitting the incorporation of epitopes from more than two loops.

Due to applicant's urgings the obviousness type double patenting rejection over the claims of Pat. 6,096,871 has been withdrawn. The examiner concurs that nucleic acid claims should not be rejected over peptide claims.

A newly stated obviousness type double patenting rejections follows.

Claims 1 and 25-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 3 and 6 - 8 of U.S. Patent No. 6,121,022. Although the conflicting claims are not identical, they are not patentably distinct from each other because. Instant claim 1 and issued claim 1 are both drawn to nucleic acids. They are recited in an identical manner except that the former recites "taken from at least one loop", while the latter recites "taken from two loops".

Since "at least one" undoubtedly encompasses "two", instant claim 1 embraces subject matter claimed by issued claim 1. A disclaimer is inquired to assure that any patent issued instantly would remain commonly owned with Patent '022.

Instant claims 21-24 recite features at forth in issued claims 2-3 and 6-7 of Patent '022. Sequences recited in instant claims 25-28 are recited in claim 8 of Patent '022. Thus all dependent claims recite features obvious over the claims of Patent '022.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Saunders, Ph.D., whose telephone number (703) 308-3976. The examiner can normally be reached on Monday-Thursday from 8:00 a.m. to 5:30 p.m. The examiner can also be reached on alternate Fridays

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan, can be reached on (703) 308-3973. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

D. Saunders: jmr
August 7, 2003

David A. Saunders
DAVID SAUNDERS
PRIMARY EXAMINER
ART UNIT ~~182~~ 1644